



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/384,326 08/26/99 YOSHIOKA

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005514 MMC2/0817
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EXAMINER

DAY M

ART UNIT

PAPER NUMBER

2879

DATE MAILED:

08/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/384,326

Applicant(s)

Yoshioka et al.

Examiner

Michael Day

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 26, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 and 56-67 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 and 56-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 07/218,203.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☒ Interview Summary (PTO-413) Paper No(s). 15
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

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DETAILED ACTION

1. The Notice of Non-Compliant Amendment, (37 CFR 1.121), mailed 4/23/01, was vacated 5/16/2001, as evidenced by the Interview Summary of the same date.
2. Amendment C and supplemental amendment D, filed 28 March 2001 and 26 April 2001, respectively, have been entered. Amendment C, and D overcome the rejection of claims 56-68 under the judicially created doctrine of obviousness-type double patenting, and the rejection of claims 56-67 under 35 U.S.C. 251.
3. The examiner hereby thanks Mr. Delucia for the candor and professionalism of the telephonic interview held 5/10/01. In the subject interview, Mr. Delucia clarified the statement found at the bottom of page 8, of amendment D. Specifically, the examiner asked where in MPEP 1412.02 does it state that the recapture doctrine does not apply when a reissue claim varies materially from a surrendered claim. Mr. Delucia stated that he was paraphrasing the section on page 1400-10 under the heading "REISSUE CLAIMS ARE NARROWER IN SCOPE IN ALL ASPECTS."
4. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR

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1.175(a)(1) and MPEP § 1414. The reissue oath/declaration does not specifically identify at least one error as required by 37 CFR 1.75(a)(1). The statement that claims 43-63 should have been included in the patent, or could have been presented is inadequate to satisfy the requirement of the rule. Specific changes with respect to the claims must be identified. Where new claims are presented, the differences between the new claims and the patent claims must be identified. It is further noted that the reissue oath/declaration of 12/27/99 fails to cover the errors/defects corrected by the amendments filed 10/16/00, 10/26/00, 4/9/01, and 4/26/01. See CFR 1.175(b)(1), and MPEP 1444.

5. Claims 1-42, and 56-67 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

6. This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest *in order to support the consent to a reissue application required by 37 CFR 1.172(a)*. The submission establishing the ownership interest of the assignee is informal. There is no indication of record that the party who signed the submission is an appropriate party to sign on behalf of the assignee. 37 CFR 3.73(b).

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A proper submission establishing ownership interest in the patent, pursuant to 37 CFR 1.172(a), is required in response to this action.

7. The person who signed the submission establishing ownership interest is not recognized as an officer of the assignee, and he/she has not been established as being authorized to act on behalf of the assignee. See MPEP § 324.

It would be acceptable for a person, other than a recognized officer, to execute a submission establishing ownership interest, provided the record for the application includes a statement that the person is empowered to sign a submission establishing ownership interest and/or act on behalf of the organization.

Accordingly, a new submission establishing ownership interest which includes such a statement above, will be considered to be executed by an appropriate official of the assignee. A separately filed paper referencing the previously filed submission establishing ownership interest and containing a proper empowerment statement would also be acceptable.

Allowable Subject Matter

8. The instant independent claim 56, as presently amended, recite "said first and second electrodes lying in substantially a same plane that is substantially parallel to the upper surface of said substrate." The first and second electrodes cannot lie in substantially a same plane, and concurrently constitute a laminate electron sources. A laminate electron sources includes an

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insulating layer disposed between opposing electrodes (see FIG. 1), which is mutually exclusive of electrodes lying in substantially a same plane. Consequently, amendment D overcomes the rejection of claims 56-67 under 35 U.S.C. 251.

9. Since allowable subject matter has been indicated, applicant is encouraged to submit formal drawings in response to this Office action. The early submission of formal drawings will permit the Office to review the drawings for acceptability and to resolve any informalities remaining therein before the application is passed to issue. This will avoid possible delays in the issue process.

Response to Arguments

10. Referring to the top of page 8 of amendment D, filed 26 April 2001, the applicant alleges that independent claims 56 varies materially from claims 67-95 of application No. 08/191,065, and that the recapture doctrine does not apply when a reissue claim varies materially from a surrendered claim. The examiner respectfully disagrees. *Ball Corp. v. U.S.* (221 USPQ 289) is not controlling law in the instant case. It is the position of the examiner rather, *In re Orita*, *Yahagi*, and *Enomoti* (CCPA) 193 USPQ 145 is controlling law in the instant case. At issue is whether the present claims 56-67 are directed to devices including laminate electron sources. The original claims 67-95 were directed to devices including laminate electron sources. The original claims 67-95 were canceled without prejudice or disclaimer of the subject matter to preserving the

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right to file a divisional application. Deliberate cancellation of claims cannot ordinarily be considered an error within the scope of the intended meaning of 35 USC 251. Accord. In re Orita, Yahagi, and Enomoti (CCPA) 193 USPQ 145. That is to say, reissue cannot be used to circumvent the copendency requirements of 35 USC 120, and 121.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Day whose telephone number is 703/305-4941. The examiner can normally be reached on Monday-Friday, from 8:00 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nimeshkumar Patel, can be reached by phoning 703/305-4794. The Fax phone number is 703/308-7382.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 703/308-0956.

August 2, 2001


MICHAEL DAY
PRIMARY EXAMINER
GROUP 2870